

REMARKS

Applicants have carefully considered the September 28, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 9-25 are pending in this application. The Examiner is respectfully requested to acknowledge the previous cancellation of claim 1-8 at the time of filing of the present application.

In response to the Office Action dated September 28, 2004, independent claim 23 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 9-25 were rejected under 35 U.S.C. §102(b) for lack of novelty as evidenced by Momoi et al. (JP 01-185617). Claims 9-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Momoi et al. (JP 01-185617), Ota et al. (JP 10-186410), Yamaji et al. (JP 08-152651) and Iwasaki (JP 10-170949).

The Examiner requested complete English translations of these references to overcome the prior art rejections. Applicants submit herewith, complete English translations of Momoi et al. (JP 01-185617) and Iwasaki (JP 10-170949). A partial English translation of the relevant portions of

Ota et al. (JP 10-186410) are submitted herewith. Moreover, U.S. Pat. No. 5,721,601, which is the corresponding U.S. patent for Yamaji et al. (JP 08-152651), is submitted herewith. For the reasons discussed below, Applicants submit that the present claims are free from the applied art. Accordingly, the Examiner is requested to reconsider and withdraw the rejections under 35 U.S.C. §102(b) and §103(a).

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed inventions and the method disclosed by Momoi et al. (JP 01-185617) that would preclude the factual determination that Momoi et al. (JP 01-185617) identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Momoi et al. disclose fluorinating the surface of the alignment layer formed after formation of the display electrode (electrode). However, Momoi et al. neither disclose nor suggest the step of introducing an impurity element having high electronegativity into a portion of the insulator film that is formed before formation of the display electrode and not covered with the display electrode.

Accordingly, Momoi et al. fail to identically disclose each feature of the claimed invention as described in independent claim 9.

Further, Momoi et al. disclose forming a fluoride on the surface of the alignment layer covering the display electrode (electrode). Therefore, Momoi et al. do not disclose a step of forming a layer containing fluorine to be in contact with the surface of the display electrode. Accordingly, Momoi et al. fail to identically disclose each feature of the claimed invention as described in independent claim 23 (as amended).

Accordingly, based upon the foregoing, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed inventions under 35 U.S.C. § 102 predicated upon Momoi et al., for the reasons set forth *supra*. Reconsideration and withdrawal of the rejection are respectfully solicited.

Claims 9-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Momoi et al. (JP 01-185617), Ota et al. (JP 10-186410), Yamaji et al. (JP 08-152651) and Iwasaki (JP 10-170949). Applicants respectfully traverse.

Applicants submit that claims 9-25 are patentably distinct over Momoi et al. for the reasons discussed above. Accordingly, based upon the foregoing, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed inventions under 35 U.S.C. § 103 predicated upon Momoi et al., for the reasons set forth *supra*. Reconsideration and withdrawal of the rejection are respectfully solicited.

Iwasaki (JP 10-170949) discloses the step of forming a silicon oxide fluoride film before formation of the display electrode. However, Iwasaki (JP 10-170949) fails to teach or remotely suggest the step (claim 9) of introducing an impurity element having high electronegativity into at least a portion of said insulator film not covered with said display electrode after formation of said

display electrode. Further, Iwasaki discloses forming a silicon oxide fluoride film being in contact with the surface of the source electrode and the drain electrode. However, Iwasaki (JP 10-170949) does not teach or suggest the step of forming a layer containing fluorine to be in contact with the surface of the display electrode, as required by independent claim 23.

Similarly, Ota et al. (JP 10-186410) and Yamaji et al. (JP 08-152651) fail to disclose or suggest the steps of independent claims 9 and 23. Neither references disclose or suggest the step of introducing an impurity element having high electronegativity into at least a portion of said insulator film not covered with said display electrode after formation of said display electrode, as required in claim 9. Further, neither reference discloses or remotely suggest the claimed step of forming a layer containing fluorine to be in contact with the surface of the display electrode, as required by independent claim 23.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants submit that the Examiner's initial burden has not been established and, therefore, the rejections of claims 9-25 under 35 U.S.C. §103(a) should be withdrawn.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an

Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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